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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS HOFRICHTER,
JOSEPH ALEXANDER DARA-ABRAMS, and
DAVID GABRIEL GAXIOLA

Appeal 2007-3474
Application 09/705,442
Technology Center 2600

Decided: April 14, 2008

Before MAHSHID D. SAADAT, JOHN A. JEFFERY, and KARL EASTHOM, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-7, 10-14, 18-21, 28-34, 37-44, 56-62, and 64-66. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants invented a method and device for accessing applications and media content usable with a specific home network system. The home network system includes a number of electronic devices and establishes a home network configuration profile that includes device identification information associated with at least one of the electronic devices. The method and device automatically download applications and media content from a remote server to the home network based on the profile.[1]

Claim 1 is illustrative:

> 1. A process of identifying and managing applications comprising:
> determining device identification information associated with at least one electronic device included in a home network;
> determining a home network configuration profile based at least on said device identification information;
> providing said home network configuration profile to a server, wherein the server is remote from the home network;
> based on the provided home network configuration profile, automatically downloading an application from the server to the home network, the application being operative to provide to the or each electronic device, a control application, an interface application, a device interplay application, a support application, a diagnostic application, or a maintenance application; and
> executing said downloaded application within the home network.

The Examiner relies on the following prior art references to show unpatentability:

Tracton	US 6,470,378 B1	Oct. 22, 2002

[1] *See generally* Spec. 3:1-4:24 and 13:12-20.

		(filed Mar. 31, 1999)
Edson	US 6,526,581 B1	Feb. 25, 2003 (filed Aug. 3, 1999)
Shteyn	US 6,618,764 B1	Sep. 9, 2003 (filed Jun. 25, 1999)

The Examiner's rejections are as follows:

1. Claims 1-7, 10, 12-14, 18-21, 28-34, 37-44, 56-62, and 64-66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Edson and Tracton.
2. Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Edson, Tracton, and Shteyn.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs[2] and the Answer[3] for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments, which Appellants could have made but did not make in the Briefs, have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

[2] We refer to the Appeal Brief filed October 27, 2005 and the Reply Brief filed March 24, 2006 throughout this opinion.
[3] We refer to the Examiner's Answer mailed January 30, 2006 throughout this opinion.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Discussing the question of obviousness of a patent that claims a combination of known elements, *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), explains:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [*v. AG Pro, Inc.,* 425 U.S. 273 (1976)] and *Anderson's-Black Rock*[*, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740. If the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that "there was an apparent reason to combine the known elements in the fashion claimed." *Id.* at 1740-41. Such a showing requires "some

articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id*. at 1741.

If the Examiner's burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

We first consider the Examiner's rejection of claims 1-7, 10, 12-14, 18-21, 28-34, 37-44, 56-62, and 64-66 under 35 U.S.C. § 103(a) as being unpatentable by Edson and Tracton. Appellants group the arguments according to the following claims: (1) 1-7, 10, 12-14, 18-21, and 64; (2) 28-34 and 37; (3) 38-44 and 65; and (4) 56-62 and 66 (App. Br. 10-14). Below, each distinct group will be addressed.

Claims 1-7, 10, 12-14, 18-21, and 64

Claim 1 recites a process of identifying and managing applications and further defines the type of application operatively provided to an electronic device of the home network. The process also includes the step of executing the application within the home network.

Regarding representative claim 1,[4] the Examiner's rejection essentially finds that Edson teaches a process of identifying and managing applications with every claimed feature except for the steps of determining device identification information associated with at least one electronic device in the home network, providing the home network configuration profile to a remote server, and based upon the profile, downloading an application from the server to the home network (Ans. 4). The Examiner cites Tracton to teach a network system that creates a profile for a device based on a device identifier, such as a MAC address, provides the profile to a remote server, and receives application data tailored to the configuration of the device based on the device's profile (Ans. 4). Based on this teaching, the Examiner concludes that one of ordinary skill in the art at the time of the invention would have known to build a home network profile for the Edson system using device identification information associated with at least one electronic device of the network, send this profile to a server, and download appropriate application data to the Edson system based on the profile in order to tailor the data to the particular configuration of the home network (Ans. 5).

Appellants argue that: (1) Edson, Tracton, or the combination fails to teach automatically downloading an application from a server to the home network based on the home network configuration profile (App. Br. 6; Reply

[4] Appellants argue claims 1-7, 10, 12-14, 18-21, and 64 as a group (App. Br. 10-11). Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Br. 5); (2) Tracton does not teach determining device identification information and a configuration profile for electronic devices within a home network (App. Br. 6; Reply Br. 6); (3) there is no motivation to combine the references because Edson relates to a home network, while Tractor is directed to a client/server environment (App. Br. 8; Reply Br. 6); (4) the profile of Tracton is not interchangeable with the profile of the invention (App. Br. 6-7; Reply Br. 6); and (5) there is no motivation within the references or the general knowledge in the art to combine the references and the Examiner is relying on hindsight (App. Br. 8; Reply Br. 6, 9).

The issues before us are:

(1) whether the collective teachings of Edson and Tracton teach or suggest the disputed limitations of representative claim 1, namely: (a) determining device identification information and a home network configuration profile based at least on the device identification information and (b) automatically downloading an application from a server to the home network based on the home network configuration profile; and

(2) whether the references are properly combinable.

For the following reasons, we answer "yes" to both of these questions.

Edson discloses a process of identifying and managing applications within a home network having a number of electronic devices (Edson, col. 5, ll. 26-36 and col. 7, ll. 36-57). Each device within the network has an address associated with its MAC function which facilitates sending and receiving information over the device's interface (Edson, col. 11, ll. 41-65; Figs. 1 and 3). The process includes the steps of determining and

configuring a new device connected to a home network, downloading applications from a remote server to the network or device, and executing the applications within the network (Edson, col. 11, ll. 10-39, col. 12, ll. 21-31, and col. 14, ll. 52-67; Figs. 1 and 4). When these downloads occur automatically (Edson, col. 11, ll. 37-40), the process of Edson must provide some sort of configuration related to the network or device to the remote server so that the automatic updates or additions are directed to the appropriate part of the system. Otherwise, after an automatic update, the home network would not operate properly. These downloads are also operative to provide to the electronic device, the device's interface, or the network gateway a maintenance application, such as patches or upgrades (Edson, col. 11, ll. 24-27 and col. 14, ll. 52-67). Edson further discloses the network communicating with a remote server to configure and diagnose the network and suggests automatically downloading diagnostic applications from the server to the network to diagnose the network (col. 11, ll. 30-40).

Tracton discloses a process for scaling data or content within a network according to the recipient's characteristics (Tracton, col. 1, ll. 6-9). Tracton teaches the steps of creating a system profile with an identity portion based on device identification information or a hardware identifier, such as a MAC address (Tracton, col. 3, l. 55 – col. 4, l. 13 and col. 8, ll. 6-55; Figs. 3 and 8). Tracton also teaches providing this profile to a remote server and downloading data from the server to the system based on the profile in order to scale the information to the configuration of the user's

device (Tracton, col. 1, ll. 6-9, col. 3, l. 55 – col. 4, l. 13, and col. 8, ll. 6-39; Figs. 5 and 8).

In our view, the collective teachings of Edson and Tracton provide ample rationale for combining known elements in the fashion recited in claim 1. Edson expressly discusses configuring a device to an in-home network based on the specific device interface to enable automatic communications with the rest of the network (Edson, col. 11, ll. 8-19). This discussion would have suggested to one of ordinary skill in the art that the network uses some type of identification information to configure the device properly and to enable communications with other devices. Edson also discloses and suggests automatically downloading applications to the network, its devices, and its specific devices' interfaces from a remote server in order to configure the network, to obtain assistance or software, or to perform diagnostics (Edson, col. 11, ll. 8-40 and col. 14, l. 52- col. 15, l. 8). In our view, one skilled in the art would have recognized from this teaching that some type of a configuration or profile based on device identification information must be generated and delivered to the remote server in order for the downloads to be entirely automated. One skilled in the art would also have recognized that generating and sending a profile based on a device identifier to a remote server would improve the home network system of Edson by, among other things, targeting the downloads to the appropriate part of the home network.

Tracton further demonstrates that one skilled in the art would have reasonably contemplated generating and sending a configuration profile to a

remote server that includes device identification information, such as a MAC address of the device, in order to obtain data scaled or tailored to the specific user or device from a server (Tracton, col. 1, ll. 6-9, col. 3, l. 55 - col. 4, l. 13 and col. 8, ll. 6-55). Edson also discloses each device includes a unique address associated with a MAC function that assists in sending and receiving information over the device's interface (Edson, col. 11, ll. 41-60, Figs. 1 and 3). Based on these teachings, one skilled in the art would have recognized that the MAC address of Edson could additionally be used in a manner similar to Tracton, that is to improve the Edson system by determining and providing a network configuration profile that includes device identification information to a remote server and, in turn, tailoring downloaded applications to the devices in the network in accordance with the profile. Thus, while Edson and Tracton, individually, may not disclose all the limitations found in claim 1, the interrelated teachings demonstrate various reasons to combine known elements in the fashion claimed.

Appellants argue that "Tracton does not teach determining device identification information and a configuration profile for electronic devices within a *home network system*" (App. Br. 6). Rather, Appellants find that Tracton teaches sending a client, not a network, profile to a remote server. Tracton does disclose a client-server relationship; however, at least one embodiment of Tracton discloses the client has several electronic devices connected to its computing device (Tracton, col. 9, ll. 44-63; Fig. 9). The client's computing device is actually a part of a network and includes an output device, such as monitor, a display, or a recording device, and an input

device, such as a keyboard, mouse, game pad, microphone, or satellite dish (Tracton, col. 9, ll. 53-55 and 58-60). The input device, the output device, and the computing device make up a home network system, and thus, Tracton does teach determining device identification information associated with at least one electronic device of a home network and a configuration profile based on device identification information as recited.

Additionally, Tracton discloses in Figure 8 a multiple client-server system that generates distinct profiles (Tracton, col. 8, ll. 6-39; Fig. 8). One skilled in the art would have recognized this teaching of providing a profile based on specific multiple users within a network would be equally applicable to the multiple devices within a home network, such as that disclosed in Edson. As stated previously, such a teaching would improve Edson's system by providing a profile based on device identification of at least one device to a server in order to obtain customized and compatible applications for different devices within the home network.

Appellants argue that the characteristic profile of Tracton, which includes computing resources and network bandwidth, is different from the configuration profile of the invention (App. Br. 6-7; Reply B. 5-6). In Appellants' view, the characteristic profile of Tracton is "not interchangeable with the configuration profile of the present invention" (App. Br. 7) because of these distinctions. We do not agree.

We note that claim 1 recites "determining a home network configuration profile based at least on said device identification information[.]" The recited profile requires the network profile be based on

no more than the device identification information. Thus, the argument that the profile of the invention differs from Tracton, by having additional, but unrecited, properties is not commensurate with the scope of claim 1. We also find that the teachings of Tracton are combinable with Edson for the previously stated reasons.

Further, we are not persuaded by Appellants' comparison to *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000).[5] First, we do not find the present combination analogous to the rejection set forth in *Kotzab*. Second, as discussed above, Tracton discloses an embodiment directed to a network of devices as shown in Figure 9. We, therefore, find a direct suggestion in Tracton to use its teachings in a network environment, such as Edson's system. Third, as explained above, we have presented particular reasons why a skilled artisan would have selected elements from Tracton to combine with the Edson in the manner claimed.

Appellants further argue that Tracton discloses only downloading MPEG files and not applications as claim 1 requires (Reply Br. 6, 9). We acknowledge that MPEG streams are not applications. However, Edson discloses the step of downloading an application to the network. Tracton was cited merely to teach that one skilled in the art would have known to download specifically tailored data based on a profile in order to improve a networked system, such as that disclosed by Edson. In our view, such a combination would have improved Edson's networked system by customizing and tailoring the downloaded application to the configuration of

[5] *See* App. Br. 9; Reply Br. 10.

a specific network or device within the network. These interrelated teachings provide ample rationale to combine the references to meet the limitation, "automatically downloading an application[,]" recited in claim 1. As the U.S. Supreme Court noted with respect to obviousness determinations, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR,* 127 S. Ct. at 1741.

Lastly, Appellants have argued that Edson, Tracton, or the combination is missing various limitations found in claim 1 (App. Br. 11). For those purportedly missing limitations discussed above, we reiterate our previous discussion and incorporate that discussion here by reference. The remaining limitations include: providing the configuration profile to a server (App. Br. 11; Reply Br. 5); the application being operative to provide to the or each electronic device a control application, an interface application, a device interplay application, a support application, a diagnostic application, or a maintenance application (App. Br. 11; Reply Br. 5); and executing the downloaded application within the home network[6] (App. Br. 11; Reply Br. 7). Apart from merely asserting that these limitations are not found in the references or the combination, Appellants do not specifically address the

[6] The Appeal and Reply Briefs state "executing an application at a device within a network of devices that was received from a server and is used to provide a remote interactive process with devices in the network of devices" (App. Br. 10; Reply Br. 7). This language does not appear in independent claim 1.

Examiner's specific positions articulated in the Answer or explain why these positions are deficient. Merely pointing out what a claim recites is not considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). In any event, such conclusory statements fall well short of rebutting the Examiner's prima facie case of obviousness – a position that we find reasonable.

For the above reasons, Appellants have not shown error in the obviousness rejection of claim 1 based on the collective teachings of Edson and Tracton. Accordingly, we sustain the rejection of claim 1 and claims 2-7, 10, 12-14, 18-21, and 64, which fall with claim 1.

Claims 28-34 and 37

Representative claim 28[7] is broader in scope than claim 1, and the preamble recites a process of identifying and accessing media content rather than applications.

Appellants present no new arguments with respect to this rejection and repeat the arguments made regarding claim 1 (App. Br. 12). Our previous discussion pertaining to the disclosure of Edson and Tracton and Appellants' mere assertions that the limitations of the claims are not found in the references or the combination applies equally here. We, therefore,

[7] Appellants argue claims 28-34 and 37 as a group (App. Br. 11-12). Accordingly, we select claim 28 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

incorporate these discussions by reference. Additionally, as discussed with respect to claim 1, any arguments regarding Tracton only teaching

downloading MPEG files or media content rather than an application are not persuasive.

For the above reasons, we affirm the rejection of claims 28-34 and 37.

Claims 38-44 and 65

Representative claim 38[8] recites an electronic device coupled to a network of devices having a communication interface through which the electronic device communicates with a remote server, a network communications interface through which the electronic device communicates with devices within the network of devices to perform many of the steps found in claim 28, and a processing circuit coupled to the communication interface and the network communications interface for executing the application to provide to the one or more devices. Claim 38, however, does not require the determined configuration profile to be based on device identification information.

The Examiner found that Edson discloses all the limitations except for the electronic device communicating with the devices within the network to determine the device identification information for a device, to provide the

[8] Appellants argue claims 38-44 and 65 as a group (App. Br. 12-13). We select claim 38 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

profile to the server, and to download automatically an application based on the profile (Ans. 9-10).[9] For these missing limitations, the Examiner relies on Tracton (Ans. 10). The Examiner then concluded that one skilled in the art would have modified Edson to include the missing limitations as taught by Tracton "in order to tailor the application data to the configuration of the home network" (Ans. 10).

Appellants present no new arguments with respect to this rejection and repeat the same arguments made regarding the rejection of claim 1 (App. Br. 12-13). Accordingly, our previous discussion pertaining to the disclosures of Edson and Tracton applies equally here, and we therefore incorporate that discussion by reference.

Furthermore, Appellants have argued that Edson, Tracton, or the combination is missing various limitations found in claim 38 (App. Br. 12-13). For those purportedly missing limitations discussed above, we reiterate our previous discussion and incorporate it here by reference. The remaining limitations include: the electronic device automatically provides the configuration profile to a remote server; an electronic device, based on the provided configuration profile, automatically downloads an application from a remote server, the application being associated with the one or more of the devices; and a processing circuit for executing the application to provide a

[9] The Answer actually states the steps of "determining device identification information," "transmitting a profile," and "automatically downloading an application" rather than the recited electronic device to determine the device identification information, to provide the profile to the server, and to download automatically an application.

control application, an interface application, a device interplay application, a support application, a diagnostic application, or a maintenance application[10] (App. Br. 13). Apart from merely asserting that these limitations are not found in the references or the combination, Appellants do not specifically address the Examiner's specific positions articulated in the Answer or explain why these positions are deficient. Merely pointing out what a claim recites is not considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). In any event, such conclusory statements fall well short of rebutting the Examiner's prima facie case of obviousness – a position that we find reasonable.

For the above stated reasons, we affirm the rejection of claims 38-44 and 65 for the same reasons.

Claims 56-62 and 66

Representative claim 56[11] is broader in scope than claim 38 and downloads media content, rather than an application.

Appellants present no new arguments with respect to this rejection (App. Br. 13-14). Our previous discussion pertaining to the disclosure of Edson and Tracton and Appellants' mere assertions that the limitations of the claims are not found in the references or the combination (App. Br. 13-

[10] The Appeal Brief actually states the step of "executing the application" to provide the listed types of applications and not a processing circuit for executing the application as recited in claim 38 (App. Br. 13).
[11] Appellants argue claims 56-62 and 67 as a group (App. Br. 13-14). We select claim 56 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

14) apply equally here. We, therefore, incorporate these discussions by reference. Additionally, as discussed with respect to claim 1, any arguments regarding Tracton only teaching downloading MPEG files or media content rather than an application are not persuasive.

For the above reasons, we affirm the rejection of claims 56-62 and 66 for the same reasons.

Claim 11

Finally, we consider the Examiner's rejection of claim 11 under 35 U.S.C. § 103 as being unpatentable by Edson, Tracton, and Shyten.

Appellants repeat the previous arguments with respect to this rejection (App. Br. 14). Accordingly, our previous discussion pertaining to the disclosure of Edson and Tracton applies equally here, and we therefore incorporate that discussion by reference.

Appellants also dispute that Shyten teaches the limitations of determining the device identification information, providing a configuration profile to the remote server, and automatically downloading an application based on the profile (App. Br. 14). Apart from merely asserting that these limitations are not found in the references or the combination, Appellants do not specifically address the Examiner's specific positions articulated in the Answer or explain why these positions are deficient. Merely pointing out what a claim recites is not considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). In any event, such conclusory

statements fall well short of rebutting the Examiner's prima facie case of obviousness – a position that we find reasonable.

Based on the above reasons, we will sustain the obviousness rejection of claim 11.

DECISION

The decision of the Examiner to reject claims 1-7, 10-14, 18-21, 28-34, 37-44, 56-62, and 64-66 is affirmed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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